

REMARKS

Restriction Requirement

In the Office Action mailed August 8, 2005, the Patent Office restricted the application to one the following inventions:

Group I - Claims 1-11, drawn to a system for fabricating polymer microparticles; or

Group II - Claims 12-35, drawn to a method of creating polymer microparticles.

Election and Traverse

In response to the Restriction Requirement, Applicant elects Group II, i.e. claims 12-35, **with traverse.**

On page 2 of the Office Action, the Patent Office states that the inventions represented by Groups I and II are distinct, each from the other. According to the Patent Office, "Invention II and I are related as process and apparatus for its practice...In this case the method as claimed can be practiced by another materially different apparatus such as a liquid comminuting apparatus followed by a chilling/solidification bath." The Office concludes that because distinctiveness has been shown, restriction is proper.

Applicants submit that restriction is not proper in this instance. M.P.E.P. § 803 states the requirement for a *proper* restriction: "There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; and (B) *There must be a serious burden on the examiner if restriction is required*" (citations omitted, emphasis added). Thus, there are *two* requirements for restriction: distinctness *and* a serious burden on the examiner. Both are required; distinctness without a serious burden is not sufficient to justify restriction. Indeed, section 803 explicitly states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added.)

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Application No. 10/656,661

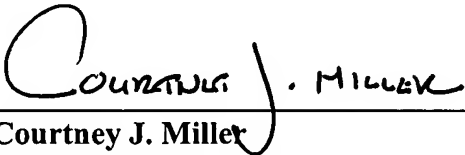
Attorney Docket No.: 22727/04137

Response to Restriction Requirement

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I and II may satisfy the Office's requirements for distinctness, their consideration would not result in a serious burden on the Office. Thus, Applicant respectfully requests that the Office consider Groups I and II together.

Respectfully submitted,

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